

REMARKS

Please reconsider the present application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering the present application.

I. Disposition of Claims

Claims 1-5 and 7-38 were pending in the present application. By way of this reply, claims 1 and 20 have been amended, claim 38 has been canceled without prejudice or disclaimer, and new claims 39-41 have been added. Accordingly, claims 1-5, 7-37, and 39-41 are currently pending in the present application.

II. Claim Amendments

Claims 1 and 20 have been amended to recite that the referred-to rubbed surface is a mechanically dry rubbed surface. No new matter has been added by way of this amendment as support for this amendment may be found, for example, on page 8, lines 17 – 20 of the present application.

III. New Claim

New claims 39-41 have been added. New claim 39, which depends from claim 1, and new claim 40, which depends from claim 20, recites that the windable printing medium further comprises a rubbing means for rubbing the base film to produce the rubbed surface, where the rubbing means is at least one of a cotton cloth and a nylon brush. No new matter has been added by way of new claims 39 and 40 as support for

new claims 39 and 40 may be found, for example, on page 8, lines 17 – 20 and on page 11, lines 6 – 10 of the present application.

New claim 41 recites a method for forming a windable printable medium in accordance with embodiments of the present invention. No new matter has been added by way of new claim 41 as support for new claim 41 may be found, for example, on page 8, line 10 – page 9, line 12.

Accordingly, entry and favorable treatment of new claims 39-41 is respectfully requested.

IV. Claim Interpretation

As indicated in the Office Action of January 14, 2004, the limitation “wherein said rubbed surface of the base film is produced by rubbing surface of the base film with at least one of a cotton cloth and a nylon brush” in claim 20 was not given patentable weight due to this limitation purportedly describing a process used to generate a product that is known in the art. By way of this reply, this limitation has been removed from claim 20.

V. Double Patenting Rejection

Claims 1-38 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,534,172 (hereinafter “the ‘172 patent”). In response, Applicant has enclosed a Terminal Disclaimer conditionally disclaiming any patent term extending beyond the expiration date of the ‘172 patent in compliance with 37 CFR 1.130(b) and 1.321(c).

Accordingly, Applicant respectfully requests the withdrawal of the obviousness-type double patenting rejection.

VI. Rejection(s) Under 35 U.S.C § 103

Claims 1-3 and 20-22

Claims 1-3 and 20-22 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,876,454 issued to Snell (hereinafter “Snell”) in view of U.S. Patent No. 4,587,158 issued to Ewing (hereinafter “Ewing”) and Japanese Reference No. 07-330929 issued to Taku (hereinafter “Taku”). For the reasons set forth below, this rejection is respectfully traversed.

The present invention is directed to an improved printing medium. As recited in amended independent claims 1 and 20 of the present application, the present invention requires a windable printing medium that comprises (i) a base film (e.g., 11 in Figures 1, 2a, 2b, 3-5, and 7a-7c of the present application) comprising a mechanically dry rubbed surface (formed by rubbing means 7 shown in Figure 1 of the present application) and an adhesive layer (e.g., 13 in Figures 2b and 3 of the present application) disposed on the rubbed surface and (ii) a printable face (e.g., 16 in Figures 7b and 7c of the present application) formed on a surface of the base film opposite the rubbed surface.

With regard to Snell, as indicated in the Office Action of January 14, 2004, Snell fails to disclose or teach the use of a rubbed surface. *See* Office Action of January 14, 2004, page 4, 2nd full paragraph. Similarly, Ewing, which discloses a label that is capable of adhering to flexible and deformable surfaces throughout cycles of mechanical stress, temperature change, etc. (*see* Ewing, column 2, lines 24 – 29), is completely silent

as to the use of a base film comprising a rubbed surface as required by amended independent claims 1 and 20 of the present application.

Taku is relied upon in the Office Action of January 14, 2004 as disclosing the rubbed surface recited in amended independent claims 1 and 20 of the present application. However, Taku fails to disclose, or otherwise teach, a base film comprising a *mechanically dry* rubbed surface. Instead, Taku discloses the use of a mechanically wet rubbed surface. *See* Taku, Abstract; page 2, paragraphs [0011] and [0012] (stating that “the roll 12 for rubbing *is flooded with the solution 13 of coupling agent*”) (emphasis added). Therefore, the purported rubbed surface in Taku is solution etched and is not and cannot be equivalent to the dry rubbed surface of the claimed invention.

As is known the art, “rubbing” a surface of the film in the presence of a solution that chemically reacts with the film results in an inherently different material from that formed by mechanically dry rubbing. *See* Taku, page 2, paragraphs [0009] – [0011]; page 3, paragraph [0019]. The methods by which the “rubbed surface” in Taku and the rubbed surface of the claimed invention are formed leads to inherently different properties and structures for the respective rubbed surfaces. In Taku, the base film must undergo a chemical change, while the rubbed surface of the claimed invention does not.

Thus, independent of the processes used to form the respective rubbed surfaces in Taku and the claimed invention, the resulting purported rubbed surface of Taku is inherently distinct in form and structure (e.g., moisture content, chemical elements, etc.) from the resulting mechanically dry rubbed surface of the claimed invention.

The use of a mechanically dry rubbed surface is advantageous for reasons such as reduced cost, less toxicity, more predictable results, etc. In view of the above, Taku fails

to disclose a base film comprising a mechanically dry rubbed surface as required by amended independent claims 1 and 20 of the present application. Accordingly, Taku fails to disclose all the limitations of amended independent claims 1 and 20 of the present application or supply that which Snell and Ewing lack.

In view of the above, Snell, Ewing, and Taku, whether considered separately or in any combination, fail to show or suggest the present invention as recited in amended independent claims 1 and 20 of the present application. Thus, amended independent claims 1 and 20 of the present application are patentable over Snell, Ewing, and Taku. Dependent claims are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 4 and 23

Claims 4 and 23 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Snell in view of Ewing and Taku, and further in view of U.S. Patent No. 5,563,023 issued to Kangas et al. (hereinafter “Kangas”) and Japanese Reference No. 4113229949 A (hereinafter “Natsume”). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Snell, Ewing, and Taku, whether viewed separately or in any combination, fail, at least, to disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by amended independent claims 1 and 20 of the present application. Both Kangas and Natsume also fail to disclose, or otherwise teach, this limitation.

Kangas, which is directed to photoimageable elements, discloses protective

coatings for photosensitive imaging layers on photoimageable elements (*see* Kangas, column 2, lines 18 – 25) and is completely silent as to a windable printing medium. Thus, Kangas necessarily cannot and does not disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by the claimed invention.

Similarly, Natsume, which is directed to colorant composition that is capable of coloring an aliphatic polyester-based biodegradable resin simultaneously with a molding of the resin (*see* Natsume, Abstract), is also completely silent as to an arrangement of layers of a windable printing medium, and thus necessarily fails to disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by the claimed invention.

Accordingly, both Kangas and Natsume fail to disclose all the limitations of amended independent claims 1 and 20 of the present application or supply that which Snell, Ewing, and Taku lack.

In view of the above, Snell, Ewing, Taku, Kangas, and Natsume, whether considered separately or in any combination, fail to show or suggest the present invention as recited in amended independent claims 1 and 20 of the present application. Moreover, the Applicant reasserts the position that one skilled in the art would not “pick and choose” features from five different patents in order to achieve the claimed invention absent the present application as a guide. From this rejection, it appears as if the Examiner may inadvertently be engaging in impermissible hindsight reconstruction. *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971); MPEP § 2145. Thus, amended independent claims 1 and 20 of the present application are patentable over Snell, Ewing,

Taku, Kangas, and Natsume. Dependent claims 4 and 23 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 5 and 24

Claims 5 and 24 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Snell in view of Ewing and Taku, and further in view of U.S. Patent No. 2,532,011 issued to Dahlquist et al. (hereinafter “Dahlquist”). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Snell, Ewing, and Taku, whether viewed separately or in any combination, fail, at least, to disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by amended independent claims 1 and 20 of the present application. Dahlquist also fails to disclose, or otherwise teach, this limitation.

Dahlquist, which is directed to low adhesion adhesive tapes (*see* Dahlquist, column 1, lines 1 –6), is completely silent as to the use of a base film comprising a mechanically dry rubbed surface as required by the claimed invention. Accordingly, Dahlquist fails to disclose all the limitations of amended independent claims 1 and 20 of the present application or supply that which Snell, Ewing, and Taku lack.

In view of the above, Snell, Ewing, Taku, and Dahlquist, whether considered separately or in any combination, fail to show or suggest the present invention as recited in amended independent claims 1 and 20 of the present application. Moreover, Dahlquist, which is solely directed to low adhesion adhesive tapes clearly “teaches away” from combining its teaching to achieve the high adhesion adhesives of the claimed

invention. A prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness; however, “the nature of the teaching is highly relevant and must be weighed in substance . . . [a] known or obvious composition does not become patentable simply because it has been described as somewhat inferior to some other product for the same use.” *In re Gurley*, 27 F.3d 551, 554 (Fed. Cir. 1994). Thus, amended independent claims 1 and 20 of the present application are patentable over Snell, Ewing, Taku, and Dahlquist. Dependent claims 5 and 24 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 7-10, 12, 13, 18, 25-27, 30, 31, and 36

Claims 7-10, 12, 13, 18, 25-27, 30, 31, and 36 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Snell in view of Ewing and Taku, and further in view of U.S. Patent No. 5,663,288 issued to Shinoda et al. (hereinafter “Shinoda”) and Japanese Reference No. 08-267968 (hereinafter “Kanshin”). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Snell, Ewing, and Taku, whether viewed separately or in any combination, fail, at least, to disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by amended independent claims 1 and 20 of the present application. Both Shinoda and Kanshin also fail to disclose, or otherwise teach, this limitation.

Shinoda, which is directed to a degradable printing medium, discloses a degradable adhesive film that uses a substrate film that can be degraded and disappeared

in the environment after use. *See* Shinoda, column 2, lines 65 – 67. Shinoda is completely silent as to an arrangement of layers of a windable printing medium, and thus necessarily cannot disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by the claimed invention.

Similarly, Kanshin, which is directed to a biodegradable card (e.g., a biodegradable credit card), is also completely silent as to an arrangement of layers of a windable printing medium, and thus necessarily cannot disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by the claimed invention. In addition, the Applicant fails to understand why one skilled in the art would look to Kanshin, which is non-analogous art. Kanshin is not reasonably related to the claimed invention, nor does it address the same technical problem.

Accordingly, Shinoda and Kanshin fail to disclose all the limitations of amended independent claims 1 and 20 of the present application or supply that which Snell, Ewing, and Taku lack.

In view of the above, Snell, Ewing, Taku, Shinoda, and Kanshin, whether considered separately or in any combination, fail to show or suggest the present invention as recited in amended independent claims 1 and 20 of the present application. Moreover, the Applicant reasserts the position that one skilled in the art would not “pick and choose” features from six different patents in order to achieve the claimed invention absent the present application as a guide. From this rejection, it appears as if the Examiner may inadvertently be engaging in impermissible hindsight reconstruction. *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971); MPEP § 2145. Thus, amended independent claims 1 and 20 of the present application are patentable over Snell, Ewing,

Taku, Shinoda, and Kanshin. Dependent claims 7-10, 12, 13, 18, 25-27, 30, 31, and 36 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 7, 8, 11, 25, 26, and 29

Claims 7, 8, 11, 25, 26, and 29 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Snell in view of Ewing and Taku, and further in view of U.S. Patent No. 6,235,825 issued to Yoshida et al. (hereinafter “Yoshida”). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Snell, Ewing, and Taku, whether viewed separately or in any combination, fail, at least, to disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by amended independent claims 1 and 20 of the present application. Yoshida also fails to disclose, or otherwise teach, this limitation.

Yoshida, which is directed to a polylactic acid-based resin composition, discloses obtaining such a composition by mixing polylactic acid-based resin with specific flexible aliphatic polyester and blending the resultant mixture with a biodegradable plasticizer having good compatibility with the resultant mixture. *See* Yoshida, column 2, lines 31 – 38. Yoshida is completely silent as to an arrangement of layers of a windable printing medium, and thus necessarily cannot and does not disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by the claimed invention. Accordingly, Yoshida fails to disclose all the limitations of amended independent claims 1 and 20 of the present application or supply that which Snell, Ewing,

and Taku lack.

In view of the above, Snell, Ewing, Taku, and Yoshida, whether considered separately or in any combination, fail to show or suggest the present invention as recited in amended independent claims 1 and 20 of the present application. Thus, amended independent claims 1 and 20 of the present application are patentable over Snell, Ewing, Taku, and Yoshida. Dependent claims 7, 8, 11, 25, 26, and 29 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 14-16 and 32-34

Claims 14-16 and 32-34 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Snell in view of Ewing, Taku, Shinoda, and Kanshin, and further in view of U.S. Patent No. 6,162,858 issued to Auguste et al. (hereinafter “Auguste”). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Snell, Ewing, Taku, Shinoda, and Kanshin, whether viewed separately or in any combination, fail, at least, to disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by amended independent claims 1 and 20 of the present application. Auguste also fails to disclose, or otherwise teach, this limitation.

Auguste, which is directed to a printable adhesive composite, discloses a composite formed of a microporous printing-writing medium based on a high molecular weight polyolefin and a plasticizer-free pressure-sensitive adhesive. See Auguste, column 3, lines 38 – 46. Further, Applicant notes that throughout the rejections, the Examiner, seemingly interchangeably, selects materials having wildly different material

properties (e.g., polyolefins, polyactides) without regard for whether they would function together and without regard for whether one skilled in the art would use such materials. Auguste is completely silent as to an arrangement of layers of a windable printing medium, and thus necessarily cannot and does not disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by the claimed invention. Accordingly, Auguste fails to disclose all the limitations of amended independent claims 1 and 20 of the present application or supply that which Snell, Ewing, Taku, Shinoda, and Kanshin lack.

In view of the above, Snell, Ewing, Taku, Shinoda, Kanshin, and Auguste, whether considered separately or in any combination, fail to show or suggest the present invention as recited in amended independent claims 1 and 20 of the present application. Moreover, the Applicant reasserts the position that one skilled in the art would not “pick and choose” features from six different patents in order to achieve the claimed invention absent the present application as a guide. From this rejection, it appears as if the Examiner may inadvertently be engaging in impermissible hindsight reconstruction. *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971); MPEP § 2145. Thus, amended independent claims 1 and 20 of the present application are patentable over Snell, Ewing, Taku, Shinoda, Kanshin, and Auguste. Dependent claims 14-16 and 32-34 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 17, 19, 35, 37, and 38

Claims 17, 19, 35, 37, and 38 of the present application were rejected under 35

U.S.C. § 103(a) as being unpatentable over Snell in view of Ewing, Taku, Shinoda, and Kanshin, and further in view of U.S. Patent No. 6,357,871 issued to Ashida et al. (hereinafter “Ashida”). With respect to claim 38, claim 38 has been canceled by way of this reply, and accordingly, the rejection of this claim is now moot. With respect to the remaining claims, for the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Snell, Ewing, Taku, Shinoda, and Kanshin, whether viewed separately or in any combination, fail, at least, to disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by amended independent claims 1 and 20 of the present application. Ashida also fails to disclose, or otherwise teach, this limitation.

Ashida, which is directed to an ink jet recording medium, discloses a medium having a support and a layer of fine particles of a thermoplastic organic polymer, formed on the support, where the fine particles of the thermoplastic organic polymer have an average particle size within a range of from 1 to 20 μm . *See* Ashida, column 4, lines 9 – 22. Ashida is completely silent as to an arrangement of layers of a windable printing medium, and thus necessarily cannot and does not disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by the claimed invention. Accordingly, Ashida fails to disclose all the limitations of amended independent claims 1 and 20 of the present application or supply that which Snell, Ewing, Taku, Shinoda, and Kanshin lack.

In view of the above, Snell, Ewing, Taku, Shinoda, Kanshin, and Ashida, whether considered separately or in any combination, fail to show or suggest the present invention as recited in amended independent claims 1 and 20 of the present application. Moreover,

the Applicant reasserts the position that one skilled in the art would not “pick and choose” features from six different patents in order to achieve the claimed invention absent the present application as a guide. From this rejection, it appears as if the Examiner may inadvertently be engaging in impermissible hindsight reconstruction. *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971); MPEP § 2145. Thus, amended independent claims 1 and 20 of the present application are patentable over Snell, Ewing, Taku, Shinoda, Kanshin, and Ashida. Dependent claims 17, 19, 35, and 37 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 1-3 and 20-22

Claims 1-3 and 20-22 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Snell in view of Ewing and U.S. Patent No. 5,861,192 issued to Nakata et al. (hereinafter “Nakata”). For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Snell and Ewing, whether viewed separately or in combination, fail, at least, to disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by amended independent claims 1 and 20 of the present application. Nakata, as discussed below, also fails to disclose, or otherwise teach, this limitation.

Nakata, which is directed to a technique for improving an adhesive property of a polyimide film, discloses a step for “execution of a liquid applying process for treating polyimide film surface by exerting physical mechanical force on said film surface under

the condition that said film surface remains wet with water or organic solvent, or solution of organic solvent or aqueous solution.” *See* Nakata, column 2, lines 22 – 26. Thus, the purported rubbed surface of Nakata is not a mechanically *dry* rubbed surface as required by the claimed invention. Similar to that as discussed above with reference to Taku, independent of the process used to form the purported rubbed surface in Nakata and the rubbed surface in the claimed invention, the resulting purported rubbed surface in Nakata is inherently distinct in structure and properties than the rubbed surface of the claimed invention. Thus, Nakata fails to disclose the mechanically dry rubbed surface limitation of the claimed invention. Accordingly, Nakata fails to disclose all the limitations of amended independent claims 1 and 20 of the present application or supply that which Snell and Ewing lack.

In view of the above, Snell, Ewing, and Nakata, whether considered separately or in any combination, fail to show or suggest the present invention as recited in amended independent claims 1 and 20 of the present application. Thus, amended independent claims 1 and 20 of the present application are patentable over Snell, Ewing, and Nakata. Dependent claims are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 4 and 23

Claims 4 and 23 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Snell in view of Ewing and Nakata, and further in view of Kangas and Natsume. For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Snell, Ewing, and Nakata, whether viewed separately or in any combination, fail, at least, to disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by amended independent claims 1 and 20 of the present application. Both Kangas and Natsume, as discussed above, also fail to disclose, or otherwise teach, this limitation. Accordingly, Kangas and Natsume fail to disclose all the limitations of amended independent claims 1 and 20 of the present application or supply that which Snell, Ewing, and Nakata lack.

In view of the above, Snell, Ewing, Nakata, Kangas, and Natsume, whether considered separately or in combination, fail to show or suggest the present invention as recited in amended independent claims 1 and 20 of the present application. Moreover, the Applicant reasserts the position that one skilled in the art would not “pick and choose” features from five different patents in order to achieve the claimed invention absent the present application as a guide. From this rejection, it appears as if the Examiner may inadvertently be engaging in impermissible hindsight reconstruction. *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971); MPEP § 2145. Thus, amended independent claims 1 and 20 of the present application are patentable over Snell, Ewing, Nakata, Kangas, and Natsume. Dependent claims 4 and 23 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 5 and 24

Claims 5 and 24 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Snell in view of Ewing and Nakata, and further in view of Dahlquist. For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Snell, Ewing, and Nakata, whether viewed separately or in any combination, fail, at least, to disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by amended independent claims 1 and 20 of the present application. Dahlquist, as discussed above, also fails to disclose, or otherwise teach, this limitation. Moreover, as discussed above, Dahlquist “teaches away” from the claimed invention. Accordingly, Dahlquist fails to disclose all the limitations of amended independent claims 1 and 20 of the present application or supply that which Snell, Ewing, and Nakata lack.

In view of the above, Snell, Ewing, Nakata and Dahlquist, whether considered separately or in combination, fail to show or suggest the present invention as recited in amended independent claims 1 and 20 of the present application. Thus, amended independent claims 1 and 20 of the present application are patentable over Snell, Ewing, Nakata, and Dahlquist. Dependent claims 5 and 24 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 7-10, 12, 13, 18, 25-27, 30, 31, and 36

Claims 7-10, 12, 13, 18, 25-27, 30, 31, and 36 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Snell in view of Ewing and Nakata, and further in view of Shinoda and Kanshin. For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Snell, Ewing, and Nakata, whether viewed separately or in any combination, fail, at least, to disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by amended independent

claims 1 and 20 of the present application. Both Shinoda and Kanshin, as discussed above, also fail to disclose, or otherwise teach, this limitation. Accordingly, Shinoda and Kanshin fail to disclose all the limitations of amended independent claims 1 and 20 of the present application or supply that which Snell, Ewing, and Nakata lack.

In view of the above, Snell, Ewing, Nakata, Shinoda, and Kanshin, whether considered separately or in combination, fail to show or suggest the present invention as recited in amended independent claims 1 and 20 of the present application. Moreover, the Applicant reasserts the position that one skilled in the art would not “pick and choose” features from five different patents in order to achieve the claimed invention absent the present application as a guide. From this rejection, it appears as if the Examiner may inadvertently be engaging in impermissible hindsight reconstruction. *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971); MPEP § 2145. Thus, amended independent claims 1 and 20 of the present application are patentable over Snell, Ewing, Nakata, Shinoda, and Kanshin. Dependent claims 7-10, 12, 13, 18, 25-27, 30, 31, and 36 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 14-16 and 32-34

Claims 14-16 and 32-34 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Snell in view of Ewing, Nakata, Shinoda, and Kanshin, and further in view of Auguste. For the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Snell, Ewing, Nakata, Shinoda, and Kanshin whether viewed

separately or in any combination, fail, at least, to disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by amended independent claims 1 and 20 of the present application. Auguste, as discussed above, also fails to disclose, or otherwise teach, this limitation. Accordingly, Auguste fails to disclose all the limitations of amended independent claims 1 and 20 of the present application or supply that which Snell, Ewing, Nakata, Shinoda, and Kanshin lack.

In view of the above, Snell, Ewing, Nakata, Shinoda, Kanshin, and Auguste, whether considered separately or in combination, fail to show or suggest the present invention as recited in amended independent claims 1 and 20 of the present application. Moreover, the Applicant reasserts the position that one skilled in the art would not “pick and choose” features from five different patents in order to achieve the claimed invention absent the present application as a guide. From this rejection, it appears as if the Examiner may inadvertently be engaging in impermissible hindsight reconstruction. *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971); MPEP § 2145. Thus, amended independent claims 1 and 20 of the present application are patentable over Snell, Ewing, Nakata, Shinoda, Kanshin, and Auguste. Dependent claims 14-16 and 32-34 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 17, 19, 35, 37, and 38

Claims 17, 19, 35, 37, and 38 of the present application were rejected under 35 U.S.C. § 103(a) as being unpatentable over Snell in view of Ewing, Nakata, Shinoda, and Kanshin, and further in view of Ashida. With respect to claim 38, claim 38 has been

canceled by way of this reply, and accordingly, the rejection of this claim is now moot. With respect to the remaining claims, for the reasons set forth below, this rejection is respectfully traversed.

As discussed above, Snell, Ewing, Nakata, Shinoda, and Kanshin whether viewed separately or in any combination, fail, at least, to disclose a windable printing medium having a base film comprising a mechanically dry rubbed surface as required by amended independent claims 1 and 20 of the present application. Ashida, as discussed above, also fails to disclose, or otherwise teach, this limitation. Accordingly, Ashida fails to disclose all the limitations of amended independent claims 1 and 20 of the present application or supply that which Snell, Ewing, Nakata, Shinoda, and Kanshin lack.


In view of the above, Snell, Ewing, Nakata, Shinoda, Kanshin, and Ashida whether considered separately or in combination, fail to show or suggest the present invention as recited in amended independent claims 1 and 20 of the present application. Moreover, the Applicant reasserts the position that one skilled in the art would not “pick and choose” features from six different patents in order to achieve the claimed invention absent the present application as a guide. From this rejection, it appears as if the Examiner may inadvertently be engaging in impermissible hindsight reconstruction. *In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971); MPEP § 2145. Thus, amended independent claims 1 and 20 of the present application are patentable over Snell, Ewing, Nakata, Shinoda, Kanshin, and Ashida. Dependent claims 17, 19, 35, and 37 are allowable for at least the same reasons. Accordingly, withdrawal of this rejection is respectfully requested.

VII. Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 03310.002001).

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Respectfully submitted,

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